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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/551,581 | 04/18/2000 | Ralf Otto | 05552.1442 | 1852 |

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EXAMINER

BEX, PATRICIA K

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| ART UNIT | PAPER NUMBER |
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1743

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/551,581

Applicant(s)

OTTO ET AL.

Examiner

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7, now recites “the conveyor is movable in a first direction to place the plunger in a position to open the stopper, and wherein the conveyor is movable in a second direction, opposite the first direction, to place the plunger in a position to close the stopper”. The specification does not adequately support such a “bi-directional” conveyor. On page 5, lines 1-22 of the instant specification, step 3) the resulting horizontal movement of the reagent container on the guide (17) (e.g. conveyor) relative to the plunger, the lid of the reagent-container stopper is opened via the catch (15) and the reagent container is moved into the removal position....step 6-7) after the plunger (11) is moved out of the at-rest position into the working position, as a result of suitable movement of the reagent container relative to the plunger, the lid of the reagent-container stopper is closed by means of the catch (15). (Emphasis added). This does not adequately support the recitation of *a conveyor that is movable in a first direction to place the plunger in a position to open the stopper, and wherein the conveyor is movable in a second direction, opposite the first direction*, as there is no mention of any “direction” within the specification. Additionally, the specification allows for “suitable

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movement of the reagent container" to include further movement in the forward direction since the plunger is able to be moved in front of and in back of the catch. Moreover, the specification seems to support the movement of the plunger relative to the reagent container (page 7, lines 26-34).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams (USP 4,807,425).

Abrams teaches a method and device for opening and closing vials 10. The apparatus includes a cap opener positioned 42 relative to rack conveyor. The rack conveyor having a plurality of vials and transporting the vials along the test equipment 36, i.e. pipette 3. Abrams teach that the pipette have variable speed drive mechanisms such that the speed of the test equipment can be adjusted. The pipette movement is coordinated with the rack 18 drive mechanism so that the pipette is inserted into and withdrawn from each vial as it passes below the pipette. The cam operating switch mounted adjacent the pipette is triggered by the lowering of the pipette into a vial. A pneumatic structure 41 is connected to and controlled by the cam operating switch. A pneumatic tube leads from the switch to the a "T" connection 51 from which the air is diverted to a regulator of the cap opening mechanism 44, 56. As the pipette is lowered into vial 10A, the disk 44, or plunger, it is quickly raised by the air regulator 48 so that the disk

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contacts the tab 16, or catch, of the vial 10B. The continued upward movement of the disk unseals the cap 12 from the vial (column 4, line 18- column 5, line 37, Figs. 3-5). Note: claim 7, now recites a “wherein clause” describing the movement of the conveyor. As a general matter, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

(Emphasis added). The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use, (B) “adapted to” or “adapted for” clauses, (C) “wherein” clauses, or (D) “whereby” clauses, see MPEP 2106 (c). Additionally, Examiner believes the prior art device would have been fully capable of performing the same function.

Response to Arguments

5. Applicant's arguments filed August 8, 2002 have been fully considered but they are not persuasive. With respect to the previous rejection of claims 7-11 under 35 U.S.C. 102(b) as being anticipated by Abrams (USP 4,807,425), Applicant argues that Abrams disclose a first piston for opening the cap and a second piston for closing the cap, thus the same piston is not used to open and close the cap, as required by claim 7. Examiner does not agree that claim 7 requires the same piston to be used to open and close the cap. The structural limitation disclose a plunger for engaging and releasing a catch on a reagent container stopper to be opened or closed. This limitation has been interpreted to mean that the catch on the reagent container stopper is *capable of being* opened or closed. Clearly, Abrams teaches a tab 16, or catch, of the vial 10B in which a disk 44, (e.g. plunger) it is quickly raised by the air regulator 48 so that the vial is able to be opened or closed. Additionally, Applicant argues that Abrams does not teach moving the vials in

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a first direction for opening the vial and moving in an opposite direction for closing. As previously discussed above, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. (Emphasis added). The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use, (B) "adapted to" or "adapted for" clauses, (C) "wherein" clauses, or (D) "whereby" clauses, see MPEP 2106 (c). Additionally, Examiner believes the prior art device would have been fully capable of performing the same function.

Conclusion

6. No claims allowed.
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

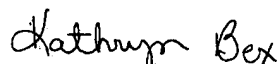
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


P. Kathryn Bex
Patent Examiner
AU 1743
October 7, 2002


Jill Warden
Supervisory Patent Examiner
Technology Center 1700